REMARKS

Reconsideration of the pending application is respectfully requested in view of the foregoing amendments and the following remarks.

Status of the Application

Claims 1-14, 16 and 18-52 are currently pending. Of these, claims 3, 4, 6-10, 15, 17-19, 21-25, 27, 28, 30-34, 36, 39-43, 45, 46 and 48-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected species. Applicants' timely traversal of the restriction (election) requirement is noted in the Office Action. In addition, Applicants have amended claims 5 and 14 to address minor typographical errors. As the amendments are fully supported by the application as filed, no new matter has been introduced into the application by way of these amendments.

Summary of the Office Action

Claims 1, 2, 11-14, 16, 26, 35 and 44 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 6,391,519 (Kunita).

Claims 5, 20, 29, 39 and 47 are rejected under 35 U.S.C. § 103(a) as being obvious over Kunita in view of U.S. Published Patent Application 2004/0048195 (Deroover et al.)

Discussion

Turning to the obviousness rejection based on Kunita, the Office Action asserts that "it would have been obvious to one having ordinary skill in the art to use an N-imide (a sub genus of both the parent genera 'imide' and 'monovalent nitrogen compounds', which one having ordinary skill in the art could at once envisage) as the group Y' in the second embodiment (II-(1)) of Kunita in order to achieve a film with a high density. *See Office Action, pages 4-5.*

Applicants respectfully traverse the assertion of obviousness set forth in the Office Action as follows.

Kunita discloses an image recording material wherein a phenolic polymer is used having one of the structures of I-(1), II-(1) and II-(2). *See, e.g., Kunita, cols. 2-4.* The polymer cited in the Office Action is II-(1), this structure being explained in detail at column

30, line 44 to column 33, line 10. The structure II-(1) is said by Kunita to be obtained by substituting the hydrogen atom of a phenolic hydroxyl group with a specific functional group –X-Y'-Z'. *See, e.g., Kunita, col. 30, lines 55-57.*

The "X" of the aforesaid functional group is taught to be a divalent linking group. *See, e.g., Kunita, col. 31, lines 46-47.*

The "Y' "of the aforesaid functional group is taught to be a divalent linking group having at least one partial structure selected from the Y'^1 groups. *See, e.g., Kunita, col. 31, lines 47-49, and the structures mentioned in the Summary of the Invention at, e.g., col. 4, lines 20-29 and col. 32, lines 1-10.* Kunita continues by stating that the partial structures of the Y'^1 group "are each a divalent linking group provided with a dissociative active hydrogen atom. The term "a dissociative hydrogen atom" as used herein means a hydrogen atom which is dissociative in a pKa range of from 4 to 15 and is known to cause a string interaction with a phenolic hydroxyl group." *See Kunita, col. 31, lines 58-65.* Kunita continues by stating "Particularly in the general formulas II-(1) and II-(2), specific examples of preferable compounds having such a partial structure may include . . . imides . . . ." *See Kunita, col. 32, lines 20-24.*

The foregoing clearly teaches that the imides (and other moieties) necessarily include the aforementioned partial structure, e.g., only imides having a dissociative active hydrogen atom. This is supported by all the examples of the partial structures listed in Y'^1 at column 32, lines 1-10 and in Y'^2 at column 32, lines 3-54; all of these groups include a dissociative active hydrogen atom (e.g., see the (acidic) hydrogen atom on the nitrogen atom of these groups).

Thus, the teaching provided by Kunita regarding the cited imide is necessarily understood by one skilled in the art as an imide having a dissociative active hydrogen atom on the nitrogen atom and that this imide is not an N-substituted imide, i.e., an imide wherein the hydrogen atom on the nitrogen is replaced by another substituting group.

In contrast, the pending claims require N-substituted imides. In other words, the claims preclude an active hydrogen on the nitrogen atom. This is in marked contrast to Kunita. Kunita teaches that it is required to have a dissociative active hydrogen atom as part

of the divalent group Y', because this hydrogen atom is necessary to form a strong interaction with a phenolic hydrogen group.

The Office Action states that when one selects an imide, N-imides are inherently included. However, this cannot be in view of the clear teaching of Kunita; Kunita's disclosure and teaching (*see, e.g., Kunita, col. 32, lines 20-24*) being limited to imides having a dissociative active hydrogen atom—the latter which is not present in an N-imide.

The Office Action further makes no distinction between Y, Y' and Y'', and further uses aspects which are only related to Kunita polymers of formula I-(1). As the polymers of formula II-(1) are more relevant than those of formula I-(1), the only disclosure of Kunita that should be used, if any, begins at col. 30, lines 44 of Kunita. *See, e.g., Office Action, page 3, wherein the citation to col. 5, lines 49-52 and page 4 wherein Y and Y' are used which only relate to I-(1) structures.*

In sum, one skilled in the art reading Kunita would be motivated to select only divalent groups which have a dissociative active hydrogen atom in the partial structures and, when an imide is selected, the selection will be limited by such teaching to those imides having an active hydrogen atom on the nitrogen atom, e.g., per the examples of Kunita provided at column 32, lines 1-10 and 30-54, and for the other reasons set forth herein.

Applicants respectfully submit that Kunita fails to teach or suggest the subject matter set forth in the claims 1, 2, 11-14, 16, 26, 35 and 44.

Turing to the rejection of claims 5, 20, 29, 39 and 47, Applicants submit that one of the references upon which the obviousness rejection is based, Deroover et al., is not prior art to the pending application, and thus may not be used in support of the obviousness rejection.

Specifically, Deroover et al. has a U.S. nonprovisional filing date of September 3, 2003. The pending application claims priority to two patent applications, each of which has a filing date that is prior to the filing date of Deroover et al., i.e., U.S. Provisional Application 60/420,907, filed October 24, 2002, and EP Patent Application 02102444.3, filed October 15, 2002. The priority claim to the EP application has been perfected by Applicants, and acknowledged by the examiner.

Withdrawal of the obviousness rejection of claims 5, 20, 29, 39 and 47 is respectfully requested on this basis alone.

To the extent it is asserted that the aforementioned priority documents do not fully support the pending claims (an assertion with which Applicants would disagree), Applicants submit that Deroover et al. is prior art to the pending application only under 35 U.S.C. § 102(e). Under the provisions of 35 U.S.C § 103(c), the obviousness rejection should be withdrawn as Deroover et al. and the subject matter claimed in the pending application were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. In support, Applicants note that Deroover et al. was assigned to AGFA-Gevaert (Reel 13993, Frame 0308, recorded on September 19, 2003), while the pending application was also assigned to AGFA-Gevaert (Reel 016527, Frame 0557, recorded September 13, 2005). Both applications are now owned by AGFA Graphics NV.

Conclusion

As Applicants believe the application is in proper condition for allowance, the examiner is respectfully requested to pass the application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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